

REMARKS

The Office Action of April 6, 2006, has been received and reviewed.

Claims 1-19 are currently pending and under consideration in the above-referenced application, each standing rejected.

Claims 20-40, which were withdrawn from consideration pursuant to a restriction requirement, have been canceled without prejudice or disclaimer.

Reconsideration of the above-referenced application is respectfully requested.

Rejections under 35 U.S.C. § 102

Claims 1-5, 7-9, and 11-19 have been rejected under 35 U.S.C. § 102(b) for being drawn to subject matter that is allegedly anticipated by the subject matter described in U.S. Patent 3,797,875 to den Hamer (hereinafter "den Hamer").

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single reference which qualifies as prior art under 35 U.S.C. § 102. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

With respect to inherency, M.P.E.P. § 2112 provides:

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) . . . 'To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill . . .'' *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1991).

The disclosure of den Hamer relates to a pen-like device for handling small objects. The den Hamer device employs an adhesive element 6 that protrudes from an end of the device. *See, e.g.*, FIG. 1; col. 2, lines 16-19.

den Hamer lacks any express description that the adhesive element of the device disclosed

disclosed therein may be used while “leaving substantially no residue.” Instead, den Hamer’s disclosure with respect to suitable adhesive element 6 materials is limited to beeswax and “numerous synthetic rubber adhesives.” Col. 1, lines 56-59. As beeswax and many synthetic rubber adhesives would leave a residue on a surface contacted thereby, den Hamer does not inherently describe each and every element of independent claim 1. *See*, M.P.E.P. § 2112.

Therefore, it den Hamer does not anticipate each and every element of independent claim 1, as would be required to maintain the 35 U.S.C. § 102(b) rejection of independent claim 1.

Each of claims 2-5, 7-9, and 11-17 is allowable, among other reasons, for depending directly or indirectly from independent claim 1, which is allowable.

Claim 3 is additionally allowable since den Hamer includes no express or inherent description that the device disclosed therein includes both a body that is configured to be grasped by the hand of an individual and a tip that is *securable to* the body. Rather, the tubes 2, 7, and 9 of the device disclosed in den Hamer appear to be permanently secured to the remainder of that device. *See* FIG. 1, specifically the enlarged tubes 7 and 9, as well as the finger key 10 that extends through a side wall of the device, which would prevent the removal of the tubes 2, 7, and 9 from the outer housing of the device.

Claim 5 is further allowable because den Hamer neither expressly nor inherently describes a device with a tip with threading that is complementary to threading of an outer housing of that device.

Claim 7 is also allowable since den Hamer does not expressly or inherently describe that the device thereof may include a cap.

Claim 11, and claims 12-17 depending directly or indirectly therefrom, are additionally allowable because den Hamer lacks any express or inherent description of a device that includes an accessory tool. Although the screw 4 and piston 5 of the device of den Hamer have been characterized by the Office as accessory tools, den Hamer does not describe that these elements are configured for any use other than to cause an adhesive element 6 to extrude from a lower end 3 of a tube within which the adhesive element 6 is disposed.

Claim 14 is further allowable because den Hamer neither expressly nor inherently describes a device that includes a rounded stylus, a placement tip, tweezers, a ball point, an adhesive applicator, a brush, a scraper, a cutting blade, a poker, or a writing or marking instrument.

Claim 15 is additionally allowable since den Hamer does not expressly or inherently describe a device that includes an accessory two with two tools that extend in different directions.

Independent claim 18, as amended and presented herein, recites a tip for a hand-held pick-and-place apparatus. The tip of amended independent claim 18 includes, among other things, a body engagement element that is configured to be rotated relative to a body of the hand-held pick-and-place apparatus so as to cause a grasping element to be extruded from the tip or retracted therein.

den Hamer includes no express or inherent description of such a tip. Rather, the description of den Hamer is limited to use of a screw 4 and piston 5 to extrude an adhesive element 6 (col. 2, lines 16-19), and a finger key 9 to extend expose and retract the adhesive element 6 (col. 2, lines 20-27).

Therefore, under 35 U.S.C. § 102(b), the subject matter recited in amended independent claim 18 is allowable over the subject matter described in den Hamer.

Claim 19 is allowable, among other reasons, for depending directly from amended independent claim 18, which is allowable.

It is respectfully requested that the 35 U.S.C. § 102(b) rejections of claims 1-5, 7-9, and 11-19 be withdrawn, and that each of these claims be allowed.

Rejections under 35 U.S.C. § 103(a)

Claims 6 and 10 have been rejected under 35 U.S.C. § 103(a) for being directed to subject matter that is purportedly unpatentable over the subject matter taught in den Hamer, in view of teachings from U.S. Patent Publication 2003/0099746 of Palmer (hereinafter "Palmer").

Claims 6 and 10 are both allowable, among other reasons, for depending from amended independent claim 1, which is allowable.

Withdrawal of the 35 U.S.C. § 103(a) rejections of claims 6 and 10 is respectfully solicited, as is the allowance of both of these claims.

CONCLUSION

It is respectfully submitted that each of claims 1-19 is allowable. An early notice of the allowability of each of these claims is respectfully solicited, as is an indication that the above-referenced application has been passed for issuance. If any issues preventing allowance of the above-referenced application remain which might be resolved by way of a telephone conference, the Office is kindly invited to contact the undersigned attorney.

Respectfully submitted,



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